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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,007	09/16/2003	Alex Dolgonos	18894-17	1755
7590 01/10/2007 John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metropolitan Square St. Louis, MO 63102			EXAMINER HO, HUY C	
			ART UNIT 2617	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/10/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/663,007	Applicant(s) DOLGONOS, ALEX	
	Examiner Huy C. Ho	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a provisional prior-filed application No. **60/411,095** filed **September 17, 2002**, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 16, 17-20 and 23** are rejected under 35 U.S.C. 102(b) as being anticipated by **Saito (EP 1148671)**.

Consider claim 16, Saito teaches a mobile unit (see **figure 10, pars [44]-[50]**), comprising:

a bi-directional communications system for receiving and sending transmissions from and to a wireless bi-directional communications network (see the abstract, **figure 10, pars [9], [44], [46]**);

a first broadcast receiver system for:

(i) receiving a real time broadcast transmission over a selected one of a plurality of selectable broadcast channels from a broadcast network having a coverage area overlapping with the bi-directional communications network (see **figures 10 and 11, pars [44]-[48]**), and

(ii) receiving a data file over a download channel from the broadcast network, the selected one broadcast channel and the download channel being different channels (see **figures 10 and 11, pars [44]-[48]**);

a storage (**figure 10, pars [45]**);

a user output device selected from the group consisting of a speaker and a display (**figure 10, pars [45]-[47]**); and

a processor connected to the communications systems, the storage and the user output device (see **figures 10 and 11, pars [45]**) for:

(i) sending a request for a playable media file through the bi-directional communications system to the wireless bi-directional communications network, the request including information identifying the mobile unit (**the abstract, pars [9], [44]-[50]**), and

(ii) receiving the data file from the broadcast network through the first broadcast receiver system and storing the data file in the storage while at the same time receiving the real time broadcast transmission from the broadcast network through the first broadcast receiver system and generating a corresponding real time output on the user output device in response thereto (**the abstract, pars [9], [44]-[50]**).

Consider claim 18, Saito teaches a method for tracking reception information for a wireless subscriber unit (see **figure 10, pars [44]-[48]**), comprising:

(a) receiving at a subscriber unit over time a plurality of selectable broadcast signals broadcast over a plurality of selectable channels by a wireless broadcast network (**pars [18], [47], [55]**);

(b) storing at the subscriber unit usage information about use by the subscriber unit of the wireless network (see **figure 10 and 11, pars [45], [53], [60]**); and

(c) transmitting the stored usage information from the subscriber unit to a bi-directional wireless communications network that has an overlapping coverage area with the broadcast network (**figure 1, the abstract, pars [6], [18], [19]**).

Consider claim 17, as applied to claim 16, Saito teaches the first broadcast receiver system is a terrestrial broadcast receiver, and the mobile unit also including a satellite receiver system (see **figures 1, 10 and 11, pars [48]**), for:

(i) receiving a real time broadcast transmission over a selected one of a plurality of selectable satellite broadcast channels from a satellite network having a coverage area overlapping with the bi-directional communications network (see the abstract, fig 10, [9], [44], [46]); and

(ii) receiving a data file over a satellite download channel from the satellite network, the selected one satellite broadcast channel and the satellite download channel being different channels;

wherein the processor is configured for receiving the data file through one of the first broadcast receiver system and the satellite receiver system and storing the data file in the storage while at the same time receiving the real time broadcast transmission through one of the first broadcast receiver system and the satellite receiver system and generating a corresponding real time output on the user output device in response thereto (see figures 10 and 11, pars [44]-[48]).

Consider claim 19, as applied to claim 18, Saito teaches the usage information is transmitted to the bi-directional wireless communications network at predetermined intervals (pars [9]-[11], [18], [27]).

Consider claim 20, as applied to claim 18, Saito teaches the usage information is transmitted to the bi-directional wireless communications network upon the subscriber unit receiving instructions over one of the bi-directional wireless communications network and the wireless broadcast network (figures 10 and 11, pars [9]-[11], [18], [27], [44]-[45], [47]).

Consider claim 23, as applied to claim 18, Saito teaches the usage information includes identification of channels audited by the subscriber unit and the time periods during which the identified channels were audited (pars [10], [30], [32], [33]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-15 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (EP 1148671) and further in view of Rothblatt (WO 99/13616).

Consider claim 1, Saito teaches a method of broadcasting information and data files to mobile units (see the abstract, figure 1, par [5]); comprising steps of:

(a) receiving, through a bi-directional wireless network, a data request from a requesting mobile unit, the data request including identification information for the requesting mobile unit (figure 1, the abstract, pars [5], [6], [11], [18], [22], [23], [70]);

(b) associating the data request with a digital data file (the abstract, pars [7], [21], [22]);

(c) broadcasting the digital data file together with identification data for the requesting mobile unit over a download channel on a broadcast network that has a plurality of broadcast channels and an overlapping coverage area with the bi-directional wireless network (figure 1, pars [7], [11], [21]-[24], [76]-[77]);

(d) Saito fails to teaches, simultaneously with step (c), broadcasting on at least one broadcast channel of the broadcast network other than the download channel a media signal for real-time reception by mobile units tuned to the at least one other broadcast channel. In an analogous art, Rothblatt teaches broadcasting on at least one broadcast channel of the broadcast network other than the download channel a media signal for real-time reception by mobile units tuned to the at least one other broadcast channel (see figure 1, page 3 lines 8-12, page 7 lines 1-10 and 17-30, page 15 lines 34-37, page 16 lines 1-3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify and incorporate Rothblatt teachings into Saito invention in order to have the featuring of broadcasting on at least one broadcast channel of the broadcast network other than the download channel a media signal for real-time reception by mobile units tuned to the at least one other broadcast channel.

Consider claim 2, as applied to claim 1, Saito, as modified by Rothblatt, further teaches:

(e) receiving the broadcast identification data at the requesting mobile unit, determining if the identification data corresponds to the requesting mobile unit, and if so, receiving and storing the digital data file at the requesting mobile unit for future use (pars [45], [69]).

Consider claim 3, as applied to claim 2, Saito, as modified by Rothblatt, teaches simultaneously with step (e) receiving the signal broadcast on the at least one other broadcast channel for real-time reception at the requesting mobile unit (see figure 1, page 3 lines 8-12, page 7 lines 1-10 and 17-30, page 15 lines 34-37, page 16 lines 1-3).

Consider claim 4, as applied to claim 1, prior to step (a), Saito, as modified by Rothblatt, teaches a step of broadcasting on the at least one other broadcast channel a prompt to encourage users of the mobile units to submit data requests for the digital data file to the bi-directional wireless network (see figure 1, page 3 lines 8-12, page 7 lines 1-10 and 17-30, page 15 lines 34-37, page 16 lines 1-3, page 25 lines 10-25).

Consider claim 5, as applied to claim 4, Saito, as modified by Rothblatt, teaches wherein the prompt includes information encouraging the users of the mobile units to contact a specified address associated with the bi-directional wireless network to request the digital data file (see fig 1, numbers 23, 25, 27, 31a/b, page 1 lines 12-15, page 2 lines 13-28).

Consider claim 6, as applied to claim 5, Saito, as modified by Rothblatt, further teaches wherein the bi-directional wireless network is a cellular network and the specified address is a telephone number (see the abstract, fig 1 numbers 20, fig 10, pars [78], [81]).

Consider claim 7, as applied to claim 6, Saito, as modified by Rothblatt, further teaches the data request includes the telephone number and in step (b) the telephone number is used as identifying information to associate the data request with the digital data file (the abstract, fig 1 numbers 20, fig 10, pars [7], [21], [22], [78], [81]);

Consider claim 8, as applied to claim 4, Saito, as modified by Rothblatt, further teaches the prompt includes information causing a real-time aural message over a speaker at receiving mobile units (see figure 10 number 14).

Consider claim 9, as applied to claim 4, Saito, as modified by Rothblatt, teaches including receiving data requests from a plurality of requesting mobile units only for a finite predetermined duration after broadcasting the prompt, the data requests each including identification information for the respective requesting mobile units, and in step (c) the digital data file is broadcast together with identification data for the requesting mobile units for which data requests were received during the finite

predetermined duration (page 3 lines 13-31, page 7 lines 18-30).

Consider claim 10, as applied to claim 1, Saito, as modified by Rothblatt, further teaches the data request includes identifying information for the digital data file, and including, between steps (b) and (c), transmitting the digital data file from a data file storage to a broadcast location for subsequent broadcast over the download channel (see figure 1 number 70, pars [21], [23], [25]-[27]).

Consider claim 11, as applied to claim 1, Saito, as modified by Rothblatt, further teaches after step (a) and prior to step (c) transmitting through the bi-directional wireless network to the requesting mobile unit information identifying the download channel (pars [74], [75] and [77]).

Consider claim 12, as applied to claim 1, Saito, as modified by Rothblatt, teaches wherein the broadcast network includes a plurality of terrestrial OFDM transmitters arranged as a single frequency network (figures 1, 2, page 9 lines 9-20).

Consider claim 13, as applied to claim 12, Saito, as modified by Rothblatt, further teaches the broadcast network broadcasts digital audio signals and the data file is a digital audio file (see figures 2, 3, pars [54], [57]).

Consider claim 14, as applied to claim 13, Saito, as modified by Rothblatt, further teaches wherein the digital audio file in an MP3 file (see figures 2, 3, pars [54], [57]).

Consider claim 15, as applied to claim 1, Saito, as modified by Rothblatt, teaches receiving from plurality of the mobile units over the bi-directional wireless network information about usage by the mobile units of the broadcast network, including information about channels tuned to by the mobile units and length of usage of the tuned to channels (figure 1, page 3 lines 4-31, page 7 lines 19-30, page 9 lines 9-30).

Consider claim 21, as applied to claim 18, Saito fails to teaches the bi-directional wireless communications network includes a plurality of base units connected to a coordinating hub, the base units having associated coverage areas for communicating with the subscriber unit as it moves through a

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coverage area of the bi-directional wireless communications network, the bi-directional wireless communications network including a dedicated control channel through which network administration information is substantially continuously communicated between the subscriber unit and the bi-directional wireless communications network, wherein in step (c) the stored usage information is transmitted through the dedicated control channel. However, it is noticeable Saito describes his invention being made in the consideration of mobile users who request the data while moving from place to place which in turn implies of the usage of a larger network connection to provide services to more users traveling (see pars [4] and [5]). In an analogous art, Rothblatt teaches the bi-directional wireless communications network includes a plurality of base units connected to a coordinating hub, the base units having associated coverage areas for communicating with the subscriber unit as it moves through a coverage area of the bi-directional wireless communications network, the bi-directional wireless communications network including a dedicated control channel through which network administration information is substantially continuously communicated between the subscriber unit and the bi-directional wireless communications network, wherein in step (c) the stored usage information is transmitted through the dedicated control channel (see the abstract, figure 1, page 5 lines 3-25, page 9 lines 9-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify and incorporate Rothblatt teachings into Saito invention in order to have the featuring the bi-directional wireless communications network includes a plurality of base units connected to a coordinating hub, the base units having associated coverage areas for communicating with the subscriber unit as it moves through a coverage area of the bi-directional wireless communications network, the bi-directional wireless communications network including a dedicated control channel through which network administration information is substantially continuously communicated between the subscriber unit and the bi-directional wireless communications network, wherein in step (c) the stored usage information is transmitted through the dedicated control channel.

Consider claim 22, as applied to claim 21, Saito, as modified by Rothblatt, teaches receiving through the control channel stored usage information from a plurality of subscriber units, and compiling the stored usage information at the coordinating hub (figure 1, page 3 lines 4-31, page 7 lines 19-30, page 9 lines 9-30).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy C. Ho whose telephone number is (571) 270-1108. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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